

REMARKS

A. 35 U.S.C. § 102

In the Office Action of September 8, 2003, claims 1-8, 34, 35, 37, 38, 48 and 49 were rejected as being anticipated under 35 U.S.C. § 102(b) by Jensen. Applicant traverses this rejection for several reasons. First, the rejection relies on combining the elements of two separate embodiments (FIG. 1 and FIGS. 2-3) to anticipate the claims under 35 U.S.C. § 102(b) which is improper. Only one embodiment can be relied on in an anticipation rejection. Despite the impropriety of the rejection, independent claims have been amended to clarify that the web lies upon the planar area. In contrast, the web P does not lie upon the toothed bar 54. Accordingly, claims 1 and 34 are not anticipated by Jensen and so the rejection should be withdrawn.

Besides not being anticipated by Jensen, claims 1 and 34 are not rendered obvious by Jensen since there is no motivation to have Jensen's web P lie upon toothed bar 54.

The rejection of claims 3 and 4 is improper because Jensen does not disclose using a moving conveyor belt as recited in the claims. The Office Action has relied on a passage in column 2 of Jensen as disclosing a moving conveyor belt. However, the passage only mentions that labels are conveyed. This does not necessarily mean that a conveyor belt is used by Jensen. Accordingly, the rejection is improper and should be withdrawn. Since there is no motivation to use a moving conveyor belt in the manner recited in the claims, the claims should be allowed.

Note that claim 3 has been amended to be in independent form. Since the amendment incorporates subject matter that is inherently present in the claim, the amendment is not being made for reasons related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), overruled

in part, 535 U.S. 722 (2002).

B. 35 U.S.C. § 103

1. Jensen and Chamberlain et al.

Claims 9-15, 26-29, 39 and 50 were rejected under 35 U.S.C § 103 as being obvious in view of Jensen and Chamberlain et al. Claims 9-15, 26-29, 39 and 50 depend directly or indirectly on claim 1 or claim 34. Chamberlain et al. does not solve the deficiencies of Jensen in that Chamberlain et al. does not suggest altering Jensen so that Jensen's web P lies upon toothed bar 54. Without such suggestion, the rejections should be withdrawn and the claims allowed.

2. Jensen and Barber et al.

Claims 16-25, 30-33, 36, 40-42, 44-49, 51 and 53 were rejected under 35 U.S.C § 103 as being obvious in view of Jensen and Barber et al. Applicant traverses the rejection of claim 53 in that claim 53 has been previously canceled. Regarding the remaining claims, they depend directly or indirectly on claim 1 or claim 34. Barber et al. does not solve the deficiencies of Jensen in that Barber et al. does not suggest altering Jensen so that Jensen's web P lies upon toothed bar 54. Without such suggestion, the rejections should be withdrawn and the claims allowed.

C. Claims 43 and 52

Applicant notes that claims 43 and 52 have not been rejected and so Applicant assumes that the claims have been deemed to contain allowable subject matter. Claims 43 and 52 are being amended in independent form. Accordingly, claims 43 and 52 should be allowed.

Please note that claims 43 and 52 have been amended so as to incorporate subject matter that was inherently present in the claims. Accordingly, the amendments of claims 43 and 52 are not being presented for reasons of patentability as defined in *Festo*.

D. Claims 56-65

Applicant notes with appreciation that claims 56-65 have been allowed.

The Office Action has provided a statement of reasons for the allowance of claim 56-65.

Applicant traverses the statement in that there are broader and other reasons why the claims are allowable.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-52 and 56-65 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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